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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,979	02/22/2002	Rajiv K. Singh	5853-223	2251

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Gregory A. Nelson, Esq.
Akerman, Senterfit & Edison, P.A.
222 Lakeview Avenue, Suite 400
P.O. Box 3188
West Palm Beach, FL 33402-3188

EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT PAPER NUMBER

1755

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,979

Applicant(s)

SINGH ET AL.

Examiner

Michael A Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Filed 7/15/03

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Applicants are reminded that in the next amendment (new copy of all the claims), claims 38-43 MUST be defined as canceled and not withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new matter is the limitation "polyhalide ion" because the specification never literally defines this newly claimed subject matter. The examiner acknowledges the definition of this, but this subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In view of the above, the new matter added to claim 1, 33, 36 and 37 is the amendment which refers to the species as a "polyhalide ion" only. The other amendments are supported by the specification. Applicants are reminded to cancel this new matter in response to this office action.

Claims 1-3, 7-16, 19-33 and 36-37 are rejected under 35 U.S.C. 103(a) as obvious over Evens.

Evens teaches in the entire document, a polishing composition comprising water and a halogen additive.

The reference teaches a composition which comprises all of the components defined by the rejected claims. Although the reference does not literally define the function of the solution, no patentable distinction is seen to exist because the solution is the same and therefore the function is expected in the composition because the same solution yields the same function. Although the reference does not literally define the thickness and types of soft layer, these limitations are the intended function of the solution and it is the examiners position that the intended function of the solution provides no patentable weight to the solution itself. With respect to the selectivity (claims 19-23 and 36-37), it is the examiners position that since the composition is the same (composition comprising the same solution), the selectivity characteristics are inherent because the same composition is expected to yield the same results. With respect to the pH value of claim 8, the claimed pH value is extremely broad (i.e. encompasses all pH values) and it is the examiners position that the pH of the reference composition (although not literally defined) inherently falls within the claimed broad range because all composition must have a pH. Finally, with respect to the use of other well known polishing additives, the use of these components would have been obvious to the skilled artisan because it is well within the level of ordinary skill in the art to incorporate any well known polishing additive(s) into polishing slurries dependent on the desired characteristics of the polishing composition sought.

Claims 1-3 and 7-37 are rejected under 35 U.S.C. 103(a) as obvious over Feller et al.

Feller et al. teach in column 4, line 47-column 5 line 55 and the claims, a polishing composition comprising water and a halogen additive.

The reference teaches a composition which comprises all of the components defined by the rejected claims. Although the reference does not literally define the function of the solution, no patentable distinction is seen to exist because the solution is the same and therefore the function is expected in the composition because the same solution yields the same function. Although the reference does not literally define the thickness and types of soft layer, these limitations are the intended function of the solution and it is the examiners position that the intended function of the solution provides no patentable weight to the solution itself. With respect to the selectivity (claims 19-23 and 36-37), it is the examiners position that since the composition is the same (composition comprising the same solution), the selectivity characteristics are inherent because the same composition is expected to yield the same results. With respect to the pH value of claim 8, the claimed pH value is extremely broad (i.e. encompasses all pH values) and it is the examiners position that the pH of the reference composition (although not literally defined) inherently falls within the claimed broad range because all composition must have a pH. Finally, with respect to the use of other well known polishing additives, the use of these components would have been obvious to the skilled artisan because it is well within the level of ordinary skill in the art to incorporate any well known polishing additive(s) into polishing slurries dependent on the desired characteristics of the polishing composition sought.

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In view of the teachings as set forth above, it is still the examiners position that the references reasonably teach or suggest the limitations of the rejected claims.

Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection.

Applicants arguments are only based on the new matter added to the claims and thus any arguments are moot.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548.

Evidence of unexpected results must be commensurate in scope with the subject matter claimed.

In re Linder 173 USPQ 356.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Marcheschi whose telephone number is (571) 272-1374. The examiner can be normally be reached on Monday through Thursday between the hours of 8:30-6:00 and every other Friday between the hours of 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Mark L. Bell, can be reached at (571) 272-1362.

Michael Marcheschi

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PRIMARY EXAMINER

2/5/04